

REMARKS

The present amendment is responsive to the Office Action dated June 8, 2006. Claims 1-2 have been amended. Claim 36 has been rewritten into independent form. New claim 59 has been added. No new matter has been added by the amendments to the claims, in rewriting claim 36 in independent form, or in adding claim 59. Support for amendments and new claim may be found, by way of example only, in the specification at the pages 23 and 24, as well as FIG. 5. Claims 34 and 35 have been cancelled. Thus, claims 1-33 and 36-59 are presented for the Examiner's consideration in view of the following remarks. A Terminal Disclaimer is also enclosed.

As an initial matter, claims 26-33 and 47-58 stand allowed. Claims 36-46 were objected to as being dependent upon a rejected base claim, and were indicated in the Office Action to be allowable if rewritten in independent form to include all limitations of the base claim and any intervening claims.

Claim 36, which originally depended from independent claim 34 and dependent claim 35, has been rewritten in independent form to include all limitations of base claim 34 and intervening claim 35. Claims 37-46 depend, either directly or indirectly, from claim 36. Therefore, applicants respectfully request that the objection to claims 36-46 be withdrawn and these claims be allowed.

Claim 34 was rejected under 35 U.S.C. § 102(b) as being anticipated by PCT Pub. No. WO99/26373 ("*Bjorn*"). Claim 35 was rejected under 35 U.S.C. § 103(a) as being obvious over *Bjorn* in view of U.S. Patent No. 4,999,661 ("*Ueno*"). As indicated above, claims 34 and 35 have been cancelled. Therefore, applicants submit that the rejections of these claims are moot.

Claims 16 and 34 were provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 33, 37, 40, 41, 42, 65 and 73 of co-pending U.S. Application No. 10/088,337 ("the '337 application"). As claim 34 has been cancelled, the provisional rejection of this claim in view of the '337 application is moot.

As discussed in the prior amendment filed in the instant case on April 7, 2006 applicants maintain that claim 16 is believed to be distinguishable from the above-identified claims of the co-pending '337 application. Nonetheless, in order to expedite prosecution of the instant case, applicants submit herewith a Terminal Disclaimer to obviate the provisional obviousness-type double patenting rejection over the '337 application.

Claims 1-7 have been rejected under 35 U.S.C. § 112, second paragraph "as being incomplete for omitting essential steps, such omission amounting to a gap between the steps." (Office Action, numbered paragraph 17, pg. 8.) Applicants note that a rejection based on an omitted essential step is more properly based under § 112, first paragraph. (See M.P.E.P. § 2172.01; see also *In re Mayhew*, 527 F.2d 1229, 1232 (CCPA 1976))

Applicants respectfully disagree with the Office Action's contention that authentication is essential or critical to the claimed invention. As noted in the Office Action with regard to the preamble of independent claim 1, the claim is directed to a method for recording data to a recording medium. The preamble makes no mention of a method for authentication or otherwise indicates that authentication is required.

The prior Office Action of December 9, 2005 asserted that there were two "essential" steps. Only one asserted essential step is presented in the pending Office Action, namely with regard to authentication. The other essential step asserted in the prior Office Action, namely "receiving the data

to be recorded," is not addressed in the pending Office Action. Applicants interpret this to mean that the essential step rejection as to a receiving limitation has been withdrawn. If this is not the case, applicants respectfully request that the Examiner so indicate in the next communication.

According to the Office Action, authentication is required for the following reason. "[W]hen it is detected that the terminal unit is connected to the recorder, the recorder authenticates the terminal unit (Specification, pg. 22, last paragraph) - this step is essential since the exchanging of the encryption key only proceeds when the terminal unit is authenticated; without authentication, the exchanging step and encrypting step do not properly secure the recorded data." (Office Action, numbered section e, pg. 8.) The cited portion of the specification states:

In step S33, the system controller 33 authenticates the input unit 40 connected to the I/F 31. When the input unit 40 has successfully be authenticated, the system controller 33 goes to step S35. On the other hand, if the input unit 40 has not successfully been authenticated in step S33, the system controller 33 goes to step S36 where it will exit the content data record mode, and then goes to step S37 wherein it will exit the procedure with displaying, on the display unit 30, a message that the input unit 40 has not successfully been authenticated.

(Specification paragraph beginning on page 22 and ending on page 23.)

However, when discussing the process including steps S33-S37, the "Best Mode for Carrying Out the Invention" in the Specification states:

Next a procedure for recording a content data to the aforementioned data recorder/player 20 will be described with reference to the flow chart shown in FIG. 5. First in step S31, the system controller 33 judges, correspondingly to an operation by the user, whether a recording

start signal has been supplied from the input controller 27. When the recording start signal is detected in step S32, the system controller 33 goes to step S32. On the other hand, if no recording start signal is detected in step S32, the system controller 33 will repeat the operation as in step S31.

(Specification at page 22, second full paragraph, emphasis added.)

Similarly, the "Brief Description of the Drawings" refers to FIG. 5 as "a flow of operations made in recording a content data to the data recorder/player." (Specification at pg. 8, emphasis added.)

As should be understood from the Best Mode and Brief Description sections of the Specification recited above, the example in FIG. 5 is an embodiment of the invention. While the embodiment associated with FIG. 5 may be preferred, it is improper to import limitations from a preferred embodiment into the claims absent a clear intention to require such limitation. As recently held by the Federal Circuit, "[w]e have repeatedly made clear that limitations cannot be imported from the specification into the claims." *Prima Tek II LLC v. Polypap S.A.R.L.*, 75 U.S.P.Q. 2d 1219, 1223 (Fed. Cir. 2005). "The claims of the patent will not be read restrictively unless the patentee has demonstrated a clear intention to limit the claim scope using words or expressions of manifest exclusion or restriction." (*Id.*, quoting *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004.))

As stated in MPEP § 2164.08(c), "an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the Abstract, omitting an allegedly critical feature, tends to rebut the argument of

criticality." (Emphasis added.) It is noted that § 2164.08(c) is clearly referenced by MPEP section 2172.01 cited in the Office Action.

"In determining whether an unclaimed feature is critical, the entire disclosure must be considered." (M.P.E.P. § 2164.08(c), emphasis added.) The Specification of the present application does not state that authentication is critical or essential to the invention. On the contrary, the Abstract states:

There is provided a method of recording data to a recording medium. For recording data to the recording medium by a recorder, it is judged whether a terminal unit with a memory having user identification information recorded therein is connected. When the terminal unit is found connected, an encryption key is exchanged between the recorder and terminal unit, user identification information read from the memory is encrypted with the exchanged encryption key, sent from the terminal unit to the recorder, and recorded to the recording medium based on the user identification information sent from the terminal unit.

The "Disclosure of the Invention" section of the application states in the first full paragraph on page 4:

The above object can be attained by providing a method of recording data to a recording medium, including steps of detecting, when a recorder is going to record data to the recording medium, whether a terminal unit with a memory having user identification information recorded therein is connected, exchanging, when it is detected that the terminal unit is connected, an encryption key between the recorder and terminal unit, encrypting the user identification information read from the memory with the exchanged encryption key and sending it from the terminal unit to the recorder, and encrypting the data to be recorded to the recording medium with the user identification information sent from the terminal unit and

recording the encrypted data to the recording medium.

Furthermore, it is improper to rely, as the Office Action does, on a dependent claim to support the contention that authentication is essential to the claimed invention. Claim 2 presents a desired additional feature. In order to clarify this, claim 2 has been modified to recite the "method according to claim 1, further comprising: the recorder authenticating the terminal unit when it is detected that the terminal unit is connected to the recorder; and when the recorder has not successfully authenticated the terminal unit, data recording to the recording medium is ceased." Thus while not intended to change the scope of claim 2, the modification is provided to make it clear that authentication may be employed as an additional step in the method if desired.

When the teachings of the pending application are taken as a whole, it should be clear that the asserted authentication element is not critical or essential to the claimed invention. Therefore, it is submitted that independent claim 1 is not incomplete for omitting a critical or otherwise essential element, and applicants respectfully request that the § 112 rejection as to claims 1-7 be withdrawn.

Applicants note that page 3 of the Office Action indicates that allowance of claims 1-7 was withdrawn "in view of the newly discovered references(s) to *Bjorn*." However, it does not appear that claims 1-7 were rejected based on *Bjorn*. Instead, these claims were rejected in view of PCT Pub. No. WO00/29928 ("*Kupka*"), which will be addressed below.

Claim 16 was rejected under 35 U.S.C. § 102(b) as being anticipated by *Kupka*. Applicants respectfully traverse the rejection.

Independent claim 16 recites: " A method of playing back a recording medium, comprising the steps of: when a player

is going to play back a recording medium containing user identification information, intended to identify a user, and data having been encrypted with the user identification information and stored in the recording medium therewith, judging whether user identification information read from an information holder provided in the player to hold user identification information sent from a terminal unit is coincident with user identification information read from the recording medium; and decrypting encrypted data read from the recording medium when the user identification information read from the information holder provided in the player is coincident with the user identification information read from the recording medium."

Kupka is directed to a system and method for distributing electronic data over a network. *Kupka* refers to a "unique serial number" for each disk, which may be created by a pseudo random number generator. (See pg. 17, 11.14-22.) "It can be appreciated that the unique identifier is not limited to information stored on the media 28 such as the serial number, and that other types of information could be used as the unique identifier, so long as it is permanently stored on the media 28." (*Kupka*, pg. 18, 1.28 to pg. 19, 1.1, emphasis added.)

Kupka does not disclose or suggest user identification information that is intended to identify a user, as required by claim 16. The Office Action states:

the use of a username to identify a user is a standard operation in the computing arts. A username is typically an alphanumeric value that identifies one user or a group of users that correspond to an account by which the user or group of users have access to a service. Furthermore, to facilitate assigning a username relevant to the user, the username is ordinarily set by the user. For example, when a user registers an application, the user selects a name

to identify the user/owner of the application.
Examiner takes Official Notice of this teaching.

(Office Action, pg. 12, numbered section 26.)

While it may be commonplace in the computing arts to employ user names "that correspond to an account by which the user or group of users have access to a service," that is not what is claimed. Instead, claim 16 employs user identification information in an entirely different manner. There is simply no teaching in *Kupka* or in the assertions by the Examiner of Official Notice of, for instance, a recording medium containing user identification information that is intended to identify a user, data encrypted with the user identification information, or the encrypted data being stored in the recording medium with the user identification information.

Thus, for at least these reasons, applicants submit that *Kupka* does not anticipate independent claim 16. Therefore, applicants respectfully submit that claim 16 is in condition for allowance.

Claims 17 and 19-25 were rejected under 35 U.S.C. § 103(a) as being obvious over *Kupka*. These claims depend from independent claim 16 and contain all the limitations thereof. Applicants submit that claims 17 and 19-25 are not obvious over *Kupka* for at least the reason stated above with regard to claim 16. Therefore, applicants submit that dependent claims 17 and 19-25 are also in condition for allowance.

Claim 18, which depends from claim 16, was rejected under 35 U.S.C. § 103(a) as being obvious over *Kupka* in view of chapter 2 of "Applied Cryptography" (hereinafter referred to as "*Schneier*"). Applicants respectfully traverse the rejection. Claim 18 depends from independent claim 16 and further requires exchanging encryption keys between two users. As acknowledged in the Office Action at pg. 13, numbered section 27, *Kupka* "does not disclose exchanging an encryption key between the player and

the terminal unit, encrypting the user identification information with the exchanged encryption key, and sending the encrypted user identification information from the terminal unit to the player." *Schneier* does not overcome the deficiencies of *Kupka* that were either acknowledged in the Office Action or otherwise presented above. For instance, *Schneier* does not disclose or suggest user identification information that is intended to identify a user in the manner required by the claim.

Thus, applicants submit that dependent claim 18 is not obvious over *Kupka* in view of *Schneier* as presented in the Office Action. Therefore, applicants respectfully submit that claim 18 is also in condition for allowance.

Claims 1-15 were also rejected under 35 U.S.C. § 103(a) as being obvious over *Kupka* in view of *Schneier*. Applicants respectfully traverse the rejection.

As acknowledged in the Office Action at pg. 10, numbered section 24, and as discussed above with regard to claim 18, *Kupka* "does not disclose exchanging an encryption key between the player and the terminal unit, encrypting the user identification information with the exchanged encryption key, and sending the encrypted user identification information from the terminal unit to the player." Furthermore, as discussed above with regard to claim 16, *Kupka* does not even disclose or suggest the user identification information required by independent claim 1.

Schneier does not overcome the deficiencies of *Kupka* that were either acknowledged in the Office Action or otherwise presented above. For instance, *Schneier* does not disclose or suggest user identification information that is intended to identify a user. Furthermore, the Official Notice taken by the Examiner does not remedy the deficiencies of *Kupka* and *Schneier*.

Thus, for at least these reasons, applicants respectfully submit that independent claim 1 is not obvious over

Kupka, *Schneier* and/or the Official Notice taken by the Examiner. Therefore, applicants respectfully submit that claim 1 is in condition for allowance.

Claims 2-15 were also rejected under 35 U.S.C. § 103(a) as being obvious over *Kupka* in view of *Schneier*. These claims depend from independent claim 1 and contain all the limitations thereof. Applicants submit that claims 2-15 are not obvious over *Kupka* and *Schneier* for at least the reasons stated above with regard to claim 1. Therefore, applicants submit that dependent claims 2-15 are also in condition for allowance.

Newly presented claim 59 depends from independent claim 1 and contains all the limitations thereof. Therefore, applicants submit that dependent claim 59 is also in condition for allowance.

As it is believed that all of the rejections set forth in the Office Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have. If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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